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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/628,607	07/31/2000	Margaret A. Moore	50160/002003	3849
21559	7590	01/14/2005		EXAMINER
CLARK & ELBING LLP 101 FEDERAL STREET BOSTON, MA 02110				POLLACK, MELVIN H
			ART UNIT	PAPER NUMBER
			2145	

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/628,607	MOORE, MARGARET A.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Melvin H Pollack	2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 05 January 2005.

2a) This action is **FINAL**.                                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-39 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-39 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. 20050105.

5) Notice of Informal Patent Application (PTO-152)

6) Other: see attached office action.

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 9/13/04 have been fully considered but they are not persuasive. A response for the rejection follows.
2. Upon further consideration, and after further review of the cited art, it has been decided that the proposed examiner's amendment raised during the prior interview will not be provided. The current rejection reads on the amendment as well.
3. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "the coach having to do with addressing ongoing concerns of clients") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). As interpreted by the examiner and not redefined by the applicant, a coach may be defined as any expert/teacher/advisor/etc. that provides information and recommendations in order to fulfill any item of concern. In the general embodiment, the coach acts as a teacher that potentially advises on health issues (claim 17), personal relationships (claim 18), taking care of another person (claims 24 and 31-33), career development (claim 25), financial help (claims 29 and 30), and so forth. The examiner states that the coach may address any concern, including those that may not be considered "ongoing concerns," especially given that the term "ongoing concerns" is broad and considered vague by the examiner. Hence, a coach may be a teacher for any subject from foreign languages to law to music. He can be a system administrator helping to maintain a user's network. He may be a career advisor, a

mentor, or a school counselor. The only requirement is that he is in a position to help a user in relation to a user's concern, be it academic or nutritional. In all of the above cases, one of ordinary skill in the art would recognize a need for user feedback, customization of sessions, and/or multiple interactions for all the experts listed above.

4. Chao teaches that the system is for teaching students a foreign language "in one embodiment (col. 1, line 59)," and that other subjects may be taught (col. 8, lines 3-5). Chao also teaches that the purpose of foreign language instruction (col. 1, lines 10-35) is to train employees in a foreign language so that they may interact with employees from other countries. The examiner considers instructional training for career retention and development to be a potential ongoing concern for a user, and a fulfillment of claim 25.

5. Even if "coach" was defined more narrowly than the specification and claims 17-33 would allow, one of ordinary skill in the art would recognize that a system that provides information about foreign languages can be used to provide information about nutrition. The particular topic of the data transmitted is irrelevant; to use a known system for a different topic is considered obvious. See *Cf. In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *In re Kuhle*, 526 F.2d 553, 555, 188 USPQ 7, 9 (CCPA 1975).

6. The examiner notes that it is well known to one of ordinary skill in the art that a person may hire a personal trainer and interact with said trainer directly. It is considered that the automation of a manual process is also non-patentable. See *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

7. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "personalized

feedback and revised recommendations") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claim states that, based on prior information, devising a set of recommendations. This may mean drafting a customized response, or it may mean simply selecting the appropriate pre-recorded response based on keywords.

8. That said, Bro teaches that a doctor (coach) chooses (devises) a set of messages (recommendations) based upon information provided by the user (col. 13, lines 30-45). Further, Bro teaches multiple broadcasts, including "customized broadcasts" (col. 16, lines 5-10; col. 19, lines 1-15) that may clearly be considered personalized feedback.

9. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "interactions are scheduled, and conducted in real time") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Nowhere in claim 1 does it state that the communication is scheduled or real-time, and claim 34 states that the interaction may be a telephone call. The claim is drawn to receiving information to the client, responding, waiting for the client to respond, etc. Such a setup is fulfilled by an e-mail conversation or bulletin-board thread. Also, since there is no indication that any time must pass between steps e) and f), the dialogue interaction of a chat room or phone conversation may also fulfill this statement.

10. That said, Bro teaches that a doctor may use two-way (real-time) conversations (col. 19, lines 15-25, and that such conversations are scheduled in advance (col. 19, lines 40-45).

11. Therefore, Bro and Chao do in fact expressly disclose the items in claim 1, as stated in the prior office action, and the rejection therefore stands.

12. In response to applicant's argument that Chao is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Chao teaches an Internet teaching system regarding the ongoing concern of learning skills in order to maintain a job and to keep up with the changing global environment, as shown above. As such, it is in the field of computerized systems to provide teachings and advisories to users, and is pertinent to the issue at hand. Therefore, the rejection stands.

13. The applicant states as evidence of non-obviousness in an affidavit under 1.132 that "an investment of over one million dollars has been made," that it has a large staff, and that Wellcoaches has entered into "major alliances... and received praise and validation." The affidavit amounts to secondary considerations which do not serve to overcome the prior art rejections.

14. For the reasons provided above, and in the previous office action, the rejection stands, and is therefore final.

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 1-4, 6, 7, 17-34, 36-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bro (5,596,994) in view of Chao et al. (6,325,632).

17. For claim 1, Bro teaches a method (see abstract) by which a company provides interactive, Internet-based, ongoing coaching to a plurality of clients (col. 1, lines 10-25), said method comprising:

- a. Providing multiple coaches (col. 7, lines 40-45; trainers);
- b. At some state in said method prior to step (f) (see below), assigning a personal online coach from multiple coaches to each said client (col. 8, lines 35-45; see below);
- c. Receiving from the client information (App. B, P. 1; col. 13, lines 15-45) particular to an ongoing concern of the client (col. 9, lines 1-10);
- d. Based on the information provided in step (c), devising a set of recommendations for the client pertinent to the client's ongoing concern (col. 13, lines 35-45);
- e. Transmitting the recommendations of step (d) to the client (App. B, P. 1);
- f. Having transmitted to the client's coach, via the Internet (col. 16, lines 17-42; col. 21, lines 44-60), particularized information from the client pertaining to the ongoing concern of the client, wherein the information includes reportage of events occurring in the life of the client subsequent to the transmittal of the recommendations of step (e) (col. 9, lines 55-60; col. 11, lines 25-35; col. 16, lines 48-55);

- g. Based on the information received by the client in step (f), having the coach devise further recommendations for the client pertinent to the ongoing concern of the client (col. 13, lines 35-45); and
- h. Transmitting the recommendations of step (g) to the client via the Internet (App. B); and
- i. Repeating steps (f) – (h) multiple times (App. B).

18. Bro teaches that one or more trainers is assigned to a client but does not expressly disclose when in the process such events occur, nor the particular mechanism for doing so. Chao teaches a method (see abstract) of setting up students (clients) with teachers (coaches) (col. 1, lines 5-10) in which the system automatically, or by student searching and choice, matches a student with a teacher (col. 2, lines 58-60) before communications between the student and the teacher begin (col. 2, lines 45-50). At the time the invention was made, one of ordinary skill in the art would have used the Chao selection process in the Bro monitoring system in order to fulfill Bro's goal of greater personalization (col. 4, lines 5-10) and to better satisfy the needs of both clients and coaches (col. 1, lines 55-65).

19. For claim 2, Bro teaches that the client and the coach communicate over the Internet at scheduled times (col. 9, lines 55-60), with real-time dialogue in the form of "chat" format typed comments and questions (i.e. pager conversation).

20. For claim 3, Bro teaches that the real-time dialogue is in the form of Internet-based telephone conversation (col. 8, lines 10-22).

21. For claim 4, Bro teaches that the real-time dialogue is in the form of Internet-based video/audio conversation (col. 34, line 49).

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22. For claims 6 and 7, Bro teaches that the coaching process includes providing to the clients incentives for reaching goals pertaining to the ongoing concern of the clients, and that said incentives include rewards provided to the clients for reaching said goals (i.e. verbal feedback such as a “Good Job” statement; col. 2, lines 30-36).

23. For claims 17-33, Bro teaches that the ongoing concern of the client pertains to a wide variety of issues (col. 1, lines 1-60; col. 10, line 43).

24. For claim 34, Bro teaches that both the client and the coach view monitors which display an electronically-stored file that contains a history of the setting and meeting of the client’s goals (col. 8, lined 23-25; col. 10, lines 55-65; col. 22, lines 15-25), and wherein the client and coach communicate via Internet chat, conventional telephony, Internet telephony, or video, or a combination thereof, while said file is displayed (col. 27, lines 4-15).

25. For claims 36 and 37, Bro teaches that the coach can see the client, and vice versa, during communication (i.e. in a videoconferencing method) (col. 34, line 49).

26. For claims 38 and 39, Bro teaches that the coach and client cannot see each other (i.e. in a phone or chat communication) (col. 8, lines 10-22).

27. Claim 5, 9, 10, 15, 16, 35 rejected under 35 U.S.C. 103(a) as being unpatentable over Bro and Chao as applied to claims 1-4, 6, 7, 17-34, 36-39 above, and further in view of Maurille (6,484,196).

28. For claim 5, Bro does not expressly disclose that the coaches are provided a web-based chat room to which both said clients and the general public are denied access. Maurille teaches a method (abstract) of implementing chat rooms and bulletin boards (col. 1, lines 5-10) such that

a private chat room can be set up for certain groups (col. 3, lines 49-60; col. 4, lines 40-50). At the time the invention was made, one of ordinary skill in the art would have supplied a secure chat room in order to ensure privacy (col. 1, lines 25-30).

29. For claims 9 and 10, Bro does not expressly disclose that the clients are provided a web-based chat room to which both said coaches and the general public are denied access. Maurille teaches a method (asbstract) of implementing chat rooms and bulletin boards (col. 1, lines 5-10) such that a private chat room can be set up for certain groups (col. 3, lines 49-60; col. 4, lines 40-50). At the time the invention was made, one of ordinary skill in the art would have supplied a secure chat room in order to ensure privacy (col. 1, lines 25-30).

30. For claims 15 and 16, Bro does not expressly disclose periodic visits to the coaches' and clients' web sites by non-coach individuals with expertise in the subject of the clients' ongoing concern. Maurille teaches the sending of invitations to join a chat session (col. 6, lines 23-40; col. 8, lines 17-19). At the time the invention was made, one of ordinary skill in the art would have combined the two inventions in order to allow new members to participate in a session.

31. For claim 35, Bro does not expressly disclose that the client has access, between coaching sessions, to said history file. Maurille teaches the recording of chat histories (col. 3, lines 13-15) so that a user can view the history at any time (col. 12, lines 45-65). At the time the invention was made, one of ordinary skill in the art would have added this feature to Bro in order to enable users to view the conversation history (col. 1, lines 10-20).

32. Claims 8, 11-14 rejected under 35 U.S.C. 103(a) as being unpatentable over Bro and Chao as applied to claims 1-4, 6, 7, 17-34, 36-39 above, and further in view of Ng (6,405,175).

33. For claim 8, Bro does not expressly disclose the awarding of points to gain awards. Ng teaches that the incentives (col. 1, lines 10-11) include the awarding of points (Fig. 5) that are redeemable for rewards (Fig. 6, #150). At the time the invention was made, one of ordinary skill in the art would have used an Ng rewards program in a Bro system in order to implement Bro's desire to inspire people to use the network (col. 2, lines 30-36).

34. For claim 11, Bro does not expressly disclose a publicity site. Ng teaches that the said method further comprises providing a publicly-accessible website that provides information about said coaching method (col. 3, lines 47-49). At the time the invention was made, one of ordinary skill in the art would have added said website to Bro so that the system may be advertised and potential and new clients may learn about it.

35. For claim 12, Bro does not expressly disclose advertising of products and services. Ng teaches that said website includes advertising of products or services not sold by the company, wherein entities other than the company pay the company to post said advertising on the website (Fig. 1, #16). Internet advertising, such as pop-up ads, are also well known in the art. At the time the invention was made, one of ordinary skill in the art would have added advertising to Bro so that Bro could gain some form of income to pay for maintenance of the equipment, etc.

36. For claim 13, Bro does not expressly disclose selling items over the site. Ng teaches that products or services are offered for sale on said website (Fig. 7). At the time the invention was made, one of ordinary skill in the art would have combined the teachings in order to provide a patient with an opportunity to purchase items necessary to fulfill the recommendations.

37. For claim 14, Bro does not expressly disclose whether clients disclose Bro experiences with prospective clients. Ng teaches that clients are offered incentives to communicate, via the

Internet, with prospective clients of the company about their experience with the coaching program (Fig. 5 and col. 13, lines 64-65). Viral advertising and recruitment schemes are also well known in the art. At the time the invention was made, one of ordinary skill in the art would have used viral marketing in order to reach out to the greater community and to gain more clients.

***Conclusion***

38. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

39. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin H Pollack whose telephone number is (571) 272-3887. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on (571) 272-3896. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MHP  
06 January 2005

  
Jack Harvey  
J. B. Harvey  
SUPERVISORY PATENT EXAMINER